



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/534,357

02/21/2006

Moussa Youdim

YOUDIM1.1A

4865

1444 7590 11/20/2009
BROWDY AND NEIMARK, P.L.L.C.
624 NINTH STREET, NW
SUITE 300
WASHINGTON, DC 20001-5303

EXAMINER

SEAMAN, D MARGARET M

ART UNIT

PAPER NUMBER

1625

MAIL DATE

DELIVERY MODE

11/20/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/534,357	Applicant(s) YOUDIM ET AL.	
	Examiner D. Margaret Seaman	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60,79-94,96-134 and 136 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-60,79-94,96-134 and 136 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1625

DETAILED ACTION

The lack of unity of invention has been recast as follows:

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1, claim(s) 1-60 and 99-109 (in part), drawn to compounds comprising an iron chelator function and a residue wherein the compound is of formula I (claim 38), with an election of a single disclosed species to aid the examiner in searching the elected invention.

Group 2, claim(s) 1-60 and 99-109 (in part), drawn to drawn to compounds comprising an iron chelator function and a residue wherein the compound is of formula II (claim 38)), with an election of a single disclosed species to aid the examiner in searching the elected invention

Group 3, claim(s) 1-60 and 99-109 (in part), drawn to compounds comprising an iron chelator function and a residue wherein the compound is of formula III (claim 38), with an election of a single disclosed species to aid the examiner in searching the elected invention.

Group 4, claim(s) 1-60 and 99-109 (in part), drawn to drawn to compounds comprising an iron chelator function and a residue wherein the compound is of formula IV (claim 38)), with an election of a single disclosed species to aid the examiner in searching the elected invention

Group 5, claim(s) 1-60 and 99-109 (in part), drawn to compounds comprising an iron chelator function and a residue wherein the compound is other than one of the formulas displayed in claim 38, with an election of a single disclosed species to aid the examiner in searching the elected invention.

Group 6, claim(s) 79-94 and 110-128, drawn to a method for iron chelation therapy using a chemical compound of claim 1 which the compound used comprises comprising an iron chelator function and a residue wherein the compound is of formula I (claim 38), with an election of a single disclosed species to aid the examiner in searching the elected invention.

Art Unit: 1625

Group 7, claim(s) 79-94 and 110-128, drawn to a method for iron chelation therapy using a chemical compound of claim 1 which the compound used comprises comprising an iron chelator function and a residue wherein the compound is of formula II (claim 38), with an election of a single disclosed species to aid the examiner in searching the elected invention.

Group 8, claim(s) 79-94 and 110-128, drawn to a method for iron chelation therapy using a chemical compound of claim 1 which the compound used comprises comprising an iron chelator function and a residue wherein the compound is of formula III (claim 38), with an election of a single disclosed species to aid the examiner in searching the elected invention.

Group 9, claim(s) 79-94 and 110-128, drawn to a method for iron chelation therapy using a chemical compound of claim 1 which the compound used comprises comprising an iron chelator function and a residue wherein the compound is of formula IV (claim 38), with an election of a single disclosed species to aid the examiner in searching the elected invention.

Group 10, claim(s) 79-94 and 110-128, drawn to a method for iron chelation therapy using a chemical compound of claim 1 which the compound used comprises comprising an iron chelator function and a residue wherein the compound is other than one of the formulas displayed in claim 38, with an election of a single disclosed species to aid the examiner in searching the elected invention.

Group 11, claim 96, drawn to a method for iron chelation therapy using the chemical compound disclosed in claim 96.

Group 12, claim 97, drawn to a cosmetic composition for topical application using the chemical compound disclosed in claim 97.

Group 13, claim 98, drawn to a method for preservation of organs intended for transplantation using the compound of claim 98.

Group 14, claims 129-134, drawn to a method for prevention or treatment of a neurodegenerative or cerebrovascular disease, condition or disorder using a compound of claim comprising an iron chelator function and a residue wherein the compound is of formula I (claim 38), with an election of a single disclosed species to aid the examiner in searching the elected invention.

Group 15, claims 129, 131-132 and 134 129-134, drawn to a method for prevention or treatment of a neurodegenerative or cerebrovascular disease, condition or disorder using a compound of claim comprising an iron chelator function and a residue wherein the compound is of formula II (claim 38), with an election of a single disclosed species to aid the examiner in searching the elected invention.

Group 16, claims 129-134, drawn to a method for prevention or treatment of a neurodegenerative or cerebrovascular disease, condition or disorder using a compound of claim comprising an iron

Art Unit: 1625

chelator function and a residue wherein the compound is of formula III (claim 38), with an election of a single disclosed species to aid the examiner in searching the elected invention.

Group 17, claims 129-134, drawn to a method for prevention or treatment of a neurodegenerative or cerebrovascular disease, condition or disorder using a compound of claim comprising an iron chelator function and a residue wherein the compound is of formula IV (claim 38), with an election of a single disclosed species to aid the examiner in searching the elected invention.

Group 18, claims 129-134, drawn to a method for prevention or treatment of a neurodegenerative or cerebrovascular disease, condition or disorder using a compound of claim 1 comprising an iron chelator function and a residue wherein the compound is other than one of the formulas displayed in claim 38, with an election of a single disclosed species to aid the examiner in searching the elected invention.

Group 19, claims 138-140, drawn to a method for preservation of organ for transplantation wherein the compound is of formula I (claim 38), with an election of a single disclosed species to aid the examiner in searching the elected invention.

Group 20, claims 138-140, drawn to a method for preservation of organ for transplantation wherein the compound is of formula II (claim 38), with an election of a single disclosed species to aid the examiner in searching the elected invention.

Group 21, claims 138-140, drawn to a method for preservation of organ for transplantation wherein the compound is of formula III (claim 38), with an election of a single disclosed species to aid the examiner in searching the elected invention.

Group 22, claims 138-140, drawn to a method for preservation of organ for transplantation wherein the compound is of formula IV (claim 38), with an election of a single disclosed species to aid the examiner in searching the elected invention.

2. The inventions listed as Groups 1-22 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Zhang article teaches neuroprotection by an iron chelator, which shows that the common core (i.e. a compound comprising an iron chelator function and a neuroprotective compound) is known. Due to this, applicant's corresponding special technical feature is known and unity of invention is broken. Applicant is asked to elect a

Art Unit: 1625

group from the above groups 1-22 and a single disclosed species to aid the examiner in the examination of the elected invention.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

4. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

Art Unit: 1625

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.

Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Margaret Seaman whose telephone number is 571-272-0694. The examiner can normally be reached on 730am-4pm, Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

D. Margaret Seaman
Primary Examiner
Art Unit 1625

/D. Margaret Seaman/
Primary Examiner, Art Unit 1625